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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,414	12/18/2001	Chi-Ming Tsai	NTI-025	4802

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EXAMINER

PROCTOR, JASON SCOTT

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/025,414

Applicant(s)

TSAL ET AL.

Examiner

Jason Proctor

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): claim 20 under 35 U.S.C. § 112, second paragraph.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-20.

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☒ Other: see attached

RESPONSE TO AFTER-FINAL AMENDMENT

1. Claims 1-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by “Lavenir CAM Software User’s Guide” by Lavenir, copyright 1999.

Amendment to the Claims

2. The amendment to the claims filed on 2 August 2005 correct formal matters and do not affect the subject matter of the claims. These amendments overcome the previous rejection of claim 20 under 35 U.S.C. § 112, second paragraph. These amendments have been entered.

Response to Rejections under 35 U.S.C. § 102(b)

3. Regarding the rejection of claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by Lavenir, Applicants’ argument states:

Because Lavenir does not teach anything about a simulation, Lavenir must also logically fail to teach storing information from that simulation in a database. Additionally, the simulation information includes deviation information that indicates a deviation of a simulated location from a corresponding location on the IC layout. Lavenir teaches neither the simulated location nor the location on an IC layout. Applicants note that determining a clearance and contact between elements (Lavenir, page 385) for a PCB does not require a simulation. (Applicants’ response, 2 August 2005, pages 8-9)

Applicants’ argument is based on the observation that Lavenir’s “simulation” is different from Applicants’ simulation therefore Lavenir’s database must be different from Applicants’ database. This argument is unpersuasive because the Applicants’ have previously traversed a 35 U.S.C. § 112 first paragraph rejection regarding the lack of enabling disclosure for Applicants’ particular simulation:

Therefore, the simulation itself is not the object of Applicants’ invention. Rather, the invention relates to a novel database that can capture information regarding that simulation to minimize the need to repeat the simulation process. (Applicants’ response, 27 April 2005, page 8, emphasis added)

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In response to this argument, the Examiner withdrew the 35 U.S.C. § 112, first paragraph, rejection for a lack of enabling disclosure and applied art that discloses a database that stores simulation data. The Examiner's interpretation of the claim, including Lavenir's "simulation", has been explained in the Office Action of 19 July 2005.

In conclusion, Applicants' previous traversal of the 35 U.S.C. § 112 first paragraph rejection contradicts the traversal of the current 35 U.S.C. § 102(b) rejection. If the prior art must show the same simulation as used by Applicants' invention, the application is not in conditions for allowance based on the lack of enabling disclosure. If the prior art need not show the same simulation as used by Applicants' invention, the application is not in conditions for allowance based on the teachings of the prior art as cited.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Proctor whose telephone number is (571) 272-3713. The examiner can normally be reached on 8:30 am-4:30 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached at (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

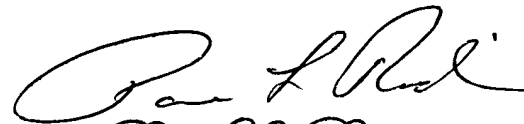
Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or

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Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason Proctor
Examiner
Art Unit 2123

jsp


Paul L. Rodriguez 8/15/05
Primary Examiner
Art Unit 2125